

PCT #9

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRANSMITTAL  
FORM

(to be used for all correspondence after filing)

Total number of Pages in this submission 25

Application Number	09/646,478
Filing Date	September 15, 2000
First Named Inventor	Jin JEN, et al.
Group Art Unit	Unassigned
Examiner Name	Unassigned
Attorney Docket No.	GZ 2108.00

Commissioner for Patents  
Washington, D.C. 20231

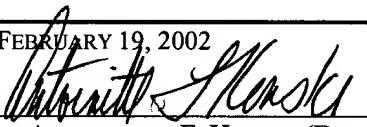
## ENCLOSURES (check all that apply)

<input type="checkbox"/> FEE TRANSMITTAL FORM	<input type="checkbox"/> ASSIGNMENT PAPERS (FOR AN APPLICATION)	<input type="checkbox"/> AFTER ALLOWANCE COMMUNICATION TO GROUP
<input type="checkbox"/> FEE ATTACHED	<input type="checkbox"/> DRAWING(S)	<input type="checkbox"/> APPEAL COMMUNICATION TO BOARD OF APPEALS AND INTERFERENCES
<input type="checkbox"/> AMENDMENT/RESPONSE	<input type="checkbox"/> LICENSING-RELATED PAPERS	
<input type="checkbox"/> AFTER FINAL	<input type="checkbox"/> PETITION ROUTING SLIP (PTO/SB/60) AND ACCOMPANYING PETITION	
<input type="checkbox"/> AFFIDAVITS' DECLARATION(S)	<input type="checkbox"/> TO CONVERT A PROVISIONAL APPLICATION	<input type="checkbox"/> APPEAL COMMUNIATION TO GROUP (APPEAL NOTICE, BRIEF, REPLY BRIEF)
<input checked="" type="checkbox"/> EXTENSION OF TIME (5-MONTH)	<input type="checkbox"/> POWER OF ATTORNEY, REVOCATION CHANGE OF CORRESPONDENCE ADDRESS	<input type="checkbox"/> PROPRIETARY INFORMATION
<input type="checkbox"/> EXPRESS ABANDONMENT REQUEST	<input type="checkbox"/> TERMINAL DISCLAIMER	<input type="checkbox"/> STATUS LETTER
<input type="checkbox"/> INFORMATION DISCLOSURE STATEMENT W/1449	<input type="checkbox"/> SMALL ENTITY STATEMENT	<input checked="" type="checkbox"/> ADDITIONAL ENCLOSURE(S) (PLEASE IDENTIFY BELOW):
<input type="checkbox"/> CERTIFIED COPY OF PRIORITY DOCUMENT(S)	<input type="checkbox"/> REQUEST FOR REFUND	RENEWED REQUEST AND PETITION FOR SUSPENSION OF THE RULES UNDER 37 CFR § 1.183, COPY OF RESPONSE TO NOTIFICATION OF A DEFECTIVE RESPONSE, STATEMENT BY OMITTED INVENTOR – DAVID SIDRANSKY, CONSENT OF ASSIGNEES TO CHANGE INVENTORSHIP. COPIES OF DECLARATIONS BY INVENTORS AS FILED AND RETURN POSTCARD
<input type="checkbox"/> RESPONSE TO MISSING PARTS/ INCOMPLETE APPLICATION		
<input type="checkbox"/> RESPONSE TO MISSING PARTS UNDER 37 CFR 1.52 OR 1.53 COPY OF PTO-1533		
<input type="checkbox"/> ISSUE FEE TRANSMITTAL		
<input type="checkbox"/>		

## REMARKS:

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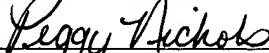
DATE: FEBRUARY 19, 2002

BY: 

ANTOINETTE F. KONSKI (REG. NO. 34,202)

## CERTIFICATE OF MAILING BY "FIRST CLASS MAIL"

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231 on this date: February 19, 2002.

By: 

Name of person signing: Peggy Nichols

Baker & McKenzie  
660 Hansen Way  
Palo Alto, CA 94304



In re Application of JEN et al  
U.S. Application No.: 09/646,478  
Int. Application No.: PCT/US99/06947  
Int. Filing Date: 30 March 1999  
Priority Date: 31 March 1998  
Attorney Docket No.: 126881201800  
For: METHODS FOR THE DIAGNOSIS AND  
TREATMENT OF LUNG CANCER

## DECISION

This is in response to applicants' "Response to Notification of a Defective Response" filed 21 May 2001 which is being treated as a request to correct inventorship.

### BACKGROUND

On 30 March 1999, applicants filed international application PCT/US99/06947, which claimed priority of an earlier United States application filed 31 March 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 12 October 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 30 September 2000.

On 15 September 2000, applicants filed national stage papers in the United States. The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 13 October 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

On 17 January 2001, applicants filed a "Response to Notice of Missing Requirements" which included, *inter alia*, a declaration, an assignment document, and the required late declaration surcharge.

On 20 April 2001, the DO/EO/US mailed a Notification of a Defective Response (Form PCT/DO/EO/916) along with a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) indicating that the declaration filed 17 January 2001 is improper since the declaration lists an inventor who is not listed on the international application.

On 21 May 2001, applicants filed the present response.

### DISCUSSION

The declaration filed 17 January 2001 lists David Sidransky as an additional inventor beyond those indicated in the international application.

The present response states that submission of the declaration should act to correct the inventorship pursuant to 37 CFR 1.48(f)(1). However, 37 CFR 1.48(f)(1) specifically refers to nonprovisional applications filed under 37 CFR 1.53(b). MPEP 201.06(c) states in relevant part, "37 CFR 1.53(b) is the section under which all applications are filed EXCEPT: (1) an application resulting from entry of an international application into the national stage under 35 U.S.C. 371 and 37 CFR 1.494 or 37 CFR 1.495. . . ." As the present application was filed under 35 U.S.C. 371, correction of inventorship cannot be effected under 37 CFR 1.48(f)(1).

37 CFR 1.497(d) (effective 07 November 2000) states,

If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in § 1.17(i); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

With regard to item (1) above, applicant has not provided the requisite statement from the purported inventor Sidransky.

With regard to item (2) above, the requisite fee has not been provided.

With regard to item (3) above, the written consent of the assignee has not been provided.

Therefore, none of the requirements of 37 CFR 1.497(d) have been satisfied.

The declaration filed 17 January 2001 is also improper for the following additional reason. It is not sufficient to submit only the signature page of the declaration.<sup>1</sup> Applicant must file either

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<sup>1</sup> It is noted that the assignment document filed 17 January 2001 is improper for the same reason.

1) a single complete declaration signed by all of the inventors or 2) multiple complete declarations, with each inventor's signature appearing on one of the multiple complete declarations.

### CONCLUSION

For the reasons above, the request to correct inventorship is **DISMISSED** without prejudice.

If reconsideration on the merits of this decision is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)" and should also include a properly executed declaration and the items set forth in 37 CFR 1.497(d). Extensions of time may be obtained pursuant to 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

  
Bryan Tung  
PCT Legal Examiner  
PCT Legal Office

Telephone: 703-308-6614  
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1/31/02

For: Shari Hall White  
Superior Patent Services

(703) 418-3670

SN 091646478

Thank You!

File Request Information

January 30, 2002

10:29:32 AM

SHARI HALL

File # Preferred# Date File Stat.

Requested

091646478 02/01/02 5110

Docket No. GZ 2018.00

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application for:

Jin JEN et al.

Serial No.: 09/646,478

Filing Date: September 15, 2000

For: METHODS FOR THE DIAGNOSIS  
AND TREATMENT OF LUNG  
CANCER

## POWER TO INSPECT

Commissioner for Patents  
Washington, D.C. 20231

Sir:

Applicants hereby grant to Superior Patent Services and his/her duly authorized representatives authorization to inspect and make copies of the files of the U.S. Patent and Trademark Office for the above-identified application for a period of 30 days from the date below.

Dated:

January 29, 2002

Respectfully submitted,

By: Antoinette F. Konski  
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Registration No. 34,202

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